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Paper No.

GDH/gdh

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Chinese Media Group
v.
Southern Chinese Newspapers Publishing Company

Cancellation No. 29,927

James E. Griffith of McDermott, Will & Emery for Chinese Media Group.

John S. Egbert of Harrison & Egbert for Southern Chinese Newspapers Publishing Company.

Before Sams, Hohein and Holtzman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Chinese Media Group has petitioned to cancel the registration owned by the Southern Chinese Newspapers Publishing Company for the mark "HOUSTON CHINESE YELLOW PAGES" for "telephone directories."¹ As grounds for cancellation,

¹ Reg. No. 2,165,903, issued on June 16, 1998 from an application filed on June 24, 1997, which sets forth a date of first use anywhere and in commerce of 1979. The words "YELLOW PAGES" are disclaimed.

petitioner alleges, among other things, that respondent's mark "HOUSTON CHINESE YELLOW PAGES is the common descriptive name for a yellow pages telephone directory for the Chinese community of Houston"; that such mark therefore "does not function to identify Respondent's goods and distinguish them from goods offered by others"; that petitioner "is likely to be damaged by continued registration of said generic term in that the evidentiary effect of said registration tends to impair Petitioner's right to legal use of said term"; and that petitioner "has for some time been involved in publishing and distributing a yellow pages directory for Houston's Chinese community and ... has a valid and legal right to refer to [such a directory] by its common descriptive name."

Petitioner further alleges that respondent's mark "is merely descriptive or primarily geographically descriptive when applied to a yellow pages directory for Houston's Chinese community in that said mark is an apt and common term used to describe" respondent's goods; that petitioner, "since 1997, has been involved in publishing and distributing yellow pages for Houston's Chinese community, and ... has a valid and legal right to describe [such] using the term registered as a trademark by Respondent"; that petitioner "is likely to be

The registration issued pursuant to the provisions of Section 2(f) of the Trademark Act, based upon a claim of five years substantially exclusive and continuous use of the mark in commerce.

damaged by the continued registration of said term in that the prima facie effect of such registration tends to impair Petitioner's right to descriptive use of the term"; that respondent "is not entitled to continue registration of its alleged mark in that Respondent is not entitled to exclusive use of said term in commerce on the goods specified"; and that respondent's "alleged mark has not become distinctive of Respondent's goods in commerce and no customer recognition of said term as a valid mark identifying only respondent has been achieved."²

Respondent, in its answer, has denied the salient allegations of the petition to cancel, including the allegations pertaining to petitioner's standing to bring this proceeding.

The record consists solely of the pleadings and the file of the involved registration. Neither party took testimony or otherwise presented any evidence at trial. Only petitioner filed a brief and neither party requested an oral hearing.

Petitioner, in the introduction to its brief, asserts that it "is a publisher of yellow pages to the Chinese

² Although petitioner also alleges a claim of fraud as a basis for cancellation, such ground was neither pursued at trial nor argued in petitioner's brief. Accordingly, the claim of fraud will not be given further consideration.

community in the Houston metropolitan area and believes it has been and continues to be damaged by the subject registration." However, such statement, as well as the allegations in the petition to cancel with respect to petitioner's standing to bring this case, are unsupported by any evidence demonstrating that petitioner has a real interest in seeking to cancel respondent's registration.³ Petitioner, therefore, has not proven its standing to be heard

³ As set forth in TBMP §706.02: "Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest." The latter, of course, is not applicable herein. Likewise, as indicated in TBMP §706.01, while "statements in pleadings may have evidentiary value as admissions against interest by the party which made them," "[s]tatements made in pleadings cannot be considered as evidence in behalf of the party making them." Instead, "such statements must be established by competent evidence during the time for taking testimony." Id.

that it is damaged by the continued existence of the involved registration. Such proof, just as is the case with proof of the genericness, mere descriptiveness and/or primary geographical descriptiveness of respondent's mark, is an essential element of petitioner's case-in-chief and, in the absence thereof, petitioner cannot prevail.

Petitioner, in its brief, appears also to request that, as evidence, judicial notice be taken of the terms "HOUSTON," "CHINESE" and "YELLOW PAGES" in respondent's mark. Citing *Filipino Yellow Pages Inc. v. Asian Journal Publications Inc.*, 198 F.3d 1143, 53 USPQ2d 1001 (9th Cir. 1999), petitioner asserts that "[t]he Ninth Circuit, in a decision determining the distinctiveness of a mark almost identical to that of Registrant, found the mark FILIPINO YELLOW PAGES to be generic for a telephone directory directed primarily at the Filipino-American community of Southern California" and that, in support of such holding:

The Ninth Circuit cited several authorities, including Webster's Ninth New Collegiate Dictionary, [at] 1367, for the proposition that both FILIPINO and YELLOW PAGES are generic terms. The central issue for the court was determining whether the combination of generic terms to form a composite mark created a generic or a descriptive mark.

Petitioner contends that "[t]he Filipino Yellow Pages case is strong precedent for the proposition that the

combination of a generic geographic designator and the words 'yellow pages' yields a generic name." According to petitioner:

HOUSTON CHINESE YELLOW PAGES is no more worthy of trademark protection than FILIPINO YELLOW PAGES. Both alleged marks are comprised of only generic terms used to denote the underlying product sold under the name, and neither title is capable of identifying source. Like "FILIPINO," "HOUSTON" and "CHINESE" are both generic terms in the context of the purported mark, and Registrant has acknowledged the genericness of the element "yellow pages" by virtue of the disclaimer contained in the registration.

Nevertheless, to the extent that petitioner bases such argument upon judicial notice of the dictionary meanings of the terms comprising respondent's mark, it is pointed out that a request for judicial notice may not be used at the briefing stage to remedy petitioner's failure to present adequate evidence to support its case. See *Litton Business Systems, Inc. v. J. G. Furniture Co., Inc.*, 190 USPQ 428, 430-31 (TTAB 1976), *recon. denied*, 190 USPQ 431, 433-34 (TTAB 1976).

Accordingly, inasmuch as petitioner is the party who bears the burden of proof in this proceeding, and because petitioner has failed to present any evidence herein, including proof of its standing to be heard, it is adjudged that the petition to cancel must fail.

Decision: The petition to cancel is denied.

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